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ROPES & GRAY LLP			GRAHAM, PAUL J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/823,985

Applicant(s)

ELLIS ET AL.

Examiner

Paul J. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: On page 2, line 30 of the specification, "...system *headed*, a broadcast ... ." should read "...system *headend*, a broadcast ... ." Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-5, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer (US 5774534) in view of Nemirofsky et al. (US 5761601).

As to claim 1, Mayer discloses in a system for scheduling advertisements for presentation to users on their television equipment (see Mayer, col. 2, ll. 30-43 for ad scheduling, col. 3, ll. 39-43 for ads on TV equip. and fig. 1.), a method comprising:

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receiving a plurality of digital interactive advertisements (see Mayer, col. 7, ll. 34-37 for plurality of ads received, col. 13, ll. 42-47 for interactive ads e.g., the user holds an “interactive call” with someone from the supply side to give specific info);

Mayer does not teach receiving electronic orders, however, Nemirofsky, who discloses distribution of ads to businesses, does teach receiving electronic orders from customers for certain interactive advertisements that the customers desire to have displayed to the users (see Nemirofsky, col. 18, ll. 28-62, e.g., a playlist contains instructions on scheduling of ads (which ads to play and when to play them based on point of purchase promotions, col. 1, ll. 34-40) received via a host computer (i.e., electronic orders) from the stores where they are to run);

and scheduling how the interactive advertisements are displayed on the television equipment of the users based on the electronic advertisement orders (see Nemirofsky, col. 18, ll. 28-62 and col. 19, ll. 3-23 e.g., a dub list is created for updated ad segments according to store inventory which may drive the orders).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Mayer with the distribution system of Nemirofsky so that advertiser and supplier input could be accounted for in the scheduling of ads (see Nemirofsky, col. 1, l. 26-col. 2, l. 20).

Nemirofsky teaches that the advertisements are digital (see Nemirofsky, col. 3, ll. 1-4).

As to claim 2, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, wherein receiving a plurality of digital interactive advertisements includes receiving a plurality of digital interactive advertisements at a main computer at a main facility (see Nemirofsky, col. 3, ll. 39-44 e.g., a distribution network in fig. 2 has a main computer).

As to claim 3, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, wherein receiving a plurality of digital interactive advertisements includes receiving a plurality of digital interactive advertisements at a local computer at a television distribution facility (see Nemirofsky, col. 3, ll. 46-51, e.g., the store's local host computer may receive and distribute the ads).

As to claim 4, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, wherein receiving electronic orders includes receiving electronic orders at a main computer at a main facility (see Nemirofsky, col. 3, ll. 39-45 and fig. 1, e.g., the invention affords comm. between the ad network and host computers and a comm. link runs between the distribution centers and the receiving sites, so the main computer could receive a playlist or electronic order).

As to claim 5, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, wherein receiving electronic orders includes receiving electronic orders at a local computer at a television distribution facility (see Nemirofsky, col. 3, ll. 39-45 and fig. 1, e.g., the invention affords comm. between the ad network and host computers, so the host computer could receive a playlist or electronic order).

As to claim 9, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, further comprising determining a price for electronic orders (see Mayer, col. 15, l. 62-col. 16, l. 10 and fig. 8).

As to claim 11, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, further comprising determining a price for electronic orders based on how the interactive advertisements are scheduled to be displayed (see Mayer, col. 15, l. 62-col. 16, l. 10 and fig. 8; e.g., the time slot when the ad is to run may determine the particular price for that ad, see the range of prices across time periods in fig. 8).

5. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer (US 5774534) in view of Nemirofsky et al. (US 5761601) in further view of Alexander et al. (US 6177931 B1).

As to claim 13, Mayer discloses a system for interactive ads displayed on TV equipment and Nemirofsky teaches electronic orders for advertisements (as combined in claim 1),

Mayer does not teach assigning priorities, however, Alexander, who discloses systems for advertising and program schedule information, does teach assigning priorities includes assigning to at least one of the interactive advertisement more than one priority (see Alexander, col. 27, ll. 2-15, ad and page priority may be assigned, for example) and displaying the interactive advertisements with the interactive television application, wherein each advertisement is displayed on one of the screens in the group to which that interactive advertisement is assigned, and wherein the interactive advertisements that are

displayed on a screen in a given screen group are displayed based on their assigned priorities (see Alexander, col. 26, ll. 45-56, ads may be assigned a specific page (screen group) and since priority is then page-specific, a set of the same ads will be successively seen on a rotational basis if that same page is accessed multiple times).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Mayer with the advertising and program scheduling system of Alexander so to segment the screen with specific space for ads so that the ads stand out on their own merit (see Alexander, col. 3, ll. 10-17).

and wherein related screens are grouped into various screen groups, a method comprising (see Mayer, col. 2, ll. 30-43 for ad scheduling, col. 3, ll. 39-43 for ads on TV equip. and fig. 1, and see fig. 1 of Alexander for various screen groups):

receiving orders for interactive advertisements to be displayed with the interactive television application (see Nemirofsky, col. 18, ll. 28-62, e.g., a playlist contains instructions on scheduling of ads (which ads to play and when to play them) received via a host computer (i.e., electronic orders) from the stores where they are to run);

assigning priorities to each of the interactive advertisements (see Alexander, col. 27, ll. 2-15, ad and page priority may be assigned, for example);

assigning each of the interactive advertisements to one of the screen groups (see Alexander, fig. 1 e.g., "ad window 1 & 2" represent assignment of ads);

As to claim 14, Mayer, Nemirofsky, and Alexander (as combined in claim 13) disclose the method defined in claim 13, wherein the interactive television application is an interactive television program guide application, and displaying includes displaying the interactive advertisements with the interactive television program guide application (see Alexander, col. 27, ll. 32-47 and fig. 10A).

As to claim 15, Mayer, Nemirofsky, and Alexander (as combined in claim 13) disclose the method defined in claim 13, Mayer does not teach assigning priorities, but, Alexander does teach assigning priorities includes assigning to at least one of the interactive advertisement more than one priority (see Alexander, col. 27, ll. 2-15, ad and page priority may be assigned, for example).

As to claim 16, Mayer, Nemirofsky, and Alexander (as combined in claim 13) disclose the method defined in claim 13, wherein assigning priorities includes assigning to at least one of the interactive advertisements more than one priority (see Alexander, col. 27, ll. 2-15, ad and page priority may be assigned, for example); and wherein assigning screen groups includes assigning a screen group in combination with each assigned priority (see Alexander, col. 26, ll. 45-56, ads may be assigned a specific page (screen group) and since priority is then page-specific, a set of the same ads will be successively seen on a rotational basis if that same page is accessed multiple times or fig. 10A & B where ads are assigned ad window 1 or 2).

6. Claims 6-8 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer (US 5774534) in view of Nemirofsky et al. (US 5761601) in further view of Schein et al. (US 6388714 B1).



As to claim 6, Mayer (and Nemirofsky as combined in claim 1) disclose method defined in claim 1,

Mayer does not teach scheduling by user TV equipment, however, Schein, who discloses an interactive TV schedule, does disclose the scheduling including scheduling by user television equipment (see Schein, col. 3, l. 54-col. 4, l. 5, e.g., from schedule on TV user may schedule his/her viewing for a period of time).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Mayer with the interactive TV schedule of Schein so that the user has the ability to schedule viewing or further explore a TV schedule from his/her user equipment (see Schein, col. 3, ll. 54-57).

As to claim 7, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, wherein receiving a plurality of digital interactive advertisements includes receiving the advertisements, Mayer does not expressly teach the use of an internet connection for transmission; however, Schein does disclose an Internet communications connection (see Schein, col. 3, l. 62-col. 4, l. 3 e.g., a webserver may transmit the info via the web or it may be available for download).

As to claim 8, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, wherein receiving electronic orders includes receiving the orders via an Internet communications connection (see Schein, col. 3, l. 62-col. 4, l. 3 e.g., a webserver may transmit the info via the web or it may be available for download, i.e., the web could carry the orders from advertiser to content source).

As to claim 17, Mayer discloses a system for interactive ads displayed on TV equipment and Nemirofsky teaches electronic orders for advertisements (as combined in claim 1, see Mayer, col. 2, ll. 30-43 for ad scheduling, col. 3, ll. 39-43 for ads on TV equip. and fig. 1),

Mayer does not teach scheduling by user TV equipment, however, Schein, who discloses an interactive TV schedule, does disclose the scheduling including scheduling by user television equipment (see Schein, col. 3, l. 54-col. 4, l. 5, e.g., from schedule on TV user may schedule his/her viewing for a period of time).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Mayer with the interactive TV schedule of Schein so that the user has the ability to schedule viewing or further explore a TV schedule (or a particular part, such as a “day part”) from his/her user equipment (see Schein, col. 3, ll. 54-57);

receiving orders for interactive advertisements to be displayed with the interactive television application (see Nemirofsky, col. 18, ll. 28-62, e.g., a playlist contains instructions on scheduling of ads (which ads to play and when to play them) received via a host computer (i.e., electronic orders) from the stores where they are to run);

assigning each interactive advertisement to a day part (see Schein, col. 18, ll. 50-60, the infomenu that comes up during Monday Night Football is context specific—specific to that day and time (and event));

and displaying the interactive advertisements with the interactive television application based on the assigned day part (see Schein, fig. 13B; e.g., a program info menu pops up with IPG functionality advertising further football items or the program guide or hotlinks to a possible website and col. 19, ll. 6-15).

As to claim 18, it is similar to claim 14 and therefore is analyzed similarly (see above).

As to claim 19, Mayer (and Nemirofsky and Schein as combined in claim 17) disclose the method defined in claim 17, wherein the orders include information on a desired day part (see Nemirofsky, col. 11, ll. 47-55 e.g., the times of day or (day parts) when ads run are customizable).

As to claim 20, Mayer (and Nemirofsky and Schein as combined in claim 17) disclose the method defined in claim 17, wherein assigning includes assigning day parts based on the received orders (see Schein, col. 15, ll. 30-38; e.g., an order (similar to a search request) may be characterized by a day part (as the search engine may allow).

7. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer (US 5774534) in view of Nemirofsky et al. (US 5761601) in further view of Peckover (US 6119101).

As to claim 10, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, further comprising determining a price for electronic orders ,

Mayer does not expressly consider info contained in the order to determine pricing; however, Peckover, who discloses agents for e-commerce, based on electronic

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order information included in each electronic order (see Peckover, col. 4, ll. 54-66, e.g., demand is represented by each order so analysis of the order (demand) is part of the determination of price).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Mayer with the agents system for e-commerce of Peckover, to gather and exchange market information to support e-commerce and thereby better serve both the consumer and advertiser (see Peckover, col. 10, l. 60-col. 11, l. 67).

As to claim 12, Mayer (and Nemirofsky as combined in claim 1) disclose the method defined in claim 1, further comprising determining a price for electronic orders based on how the interactive advertisements are scheduled to be displayed and based on delivery success rates (see Mayer, col. 15, l. 62-col. 16, l. 10 and fig. 8; e.g., the time slot when the ad is to run may determine the particular price for that ad, see the range of prices across time periods in fig. 8 and Peckover, col. 4, ll. 14-35, e.g., the delivery success rate gives the advertiser things to consider in determining a price, say for such an ad).

#### ***Inquiries***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Graham whose telephone number is 571-270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ANDREW Y. KOENIG  
PRIMARY PATENT EXAMINER

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10/23/2007